

REMARKS

Claims 1-16 remain in this application without amendment. The applicants respectfully request reconsideration of the application in light of the following remarks.

1. The claims are directed to a candidate-controlled process for disclosure of verified credentials

Claim 1 is directed to a method of providing access to a candidate's personal background data. The method first requires establishing a data record relating to the candidate's personal background data, the data record having, among other things, a candidate identifier that identifies the candidate. The method next requires *communicating the candidate identifier to the candidate*. (Emphasis added.) The method then requires receiving the candidate identifier from an outside user, *the outside user having received the candidate identifier directly or indirectly from the candidate*. (Emphasis added.) Claim 16 is directed to a system that includes limitations that are substantially similar to those just recited. Thus, in accordance with the claimed method and system, the candidate identifier is established, communicated to the candidate, received by the outside user directly or indirectly from the candidate, and finally received from the outside user. In this way, the candidate controls who may view his or her verified personal background data.

Claims 1-16 were rejected under 35 U.S.C. § 103(a) in view of US 5,884,270 (*Walker*) and further in view of US 5,867,821 (*Ballantyne*) and US 5,748,738 (*Bisbee*). The applicants respectfully request that the rejections be withdrawn, because the cited art fails to teach or suggest the above limitations of the claims as a whole. And even if the cited art did teach these limitations, the combination would not be obvious to a person having ordinary skill in the art, because it would render Walker unsuitable for its intended purpose. See MPEP 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

2. The cited prior art fails to disclose or suggest the lifecycle of the claimed candidate identifier

Walker, *Ballantyne*, and *Bisbee* fail to teach, alone or in combination, the requirements in the claims of a candidate identifier that is first established, then communicated to the candidate, received by the outside user directly or indirectly from the candidate, and finally received from the outside user. This sequence of steps is important, because it gives the candidate complete control over who may access his personal background information, while simultaneously

preventing him from presenting false information, thereby solving a long-standing problem in a novel way.

As a preliminary matter, the Examiner correctly notes that Walker fails to disclose such a candidate identifier. Office Action, p. 3. To fill the gap left by Walker, the Office argues that Ballantyne teaches the claimed candidate identifier. The Office cites col. 8, lines 17-29 of Ballantyne, which states in part that a “unique identification number (ID) is assigned to each user and their personal profile data is stored electronically online.” However, the claims require communicating the candidate identifier to the candidate, and the ID described in Ballantyne does not identify a candidate but a medical professional who is already employed. Even assuming, for the sake of argument, that a medical professional is somehow a “candidate,” the claims require an outside user having received the candidate identifier directly or indirectly from the candidate. As explained in the passage in Ballantyne immediately following the one cited by the Office, the ID is received from the medical professional himself, not from an outside user. In fact, the received ID number is validated with a central user list to confirm that the user is not an outside user. Ballantyne, col. 8, lines 28-31. Ballantyne thus teaches away from limitations (b) and (c) of claim 1, and the corresponding limitations of claim 16.

In fact, Ballantyne is inapposite for another related reason. The claims require that the candidate receive the candidate identifier that permits access to the candidate’s verified information. Assuming for the moment that Ballantyne has any relevance whatsoever to the claimed subject matter (since no candidate nor outside user is identified in Ballantyne), it is the patient’s verified information that is being accessed and used, not that of the medical professional accessing the network terminal. The patient information in Ballantyne is never described as being accessible by an identifier passed on to the patient, as required by the claims. Because Ballantyne fails to fill the gap left by Walker, the applicants respectfully request that the rejection be withdrawn.

The Examiner also admits that Walker and Ballantyne fail to disclose limitations (c) or (d) of claim 1, or their counterparts in claim 16, and cites Bisbee as meeting these limitations. Office Action, pp. 4, 8. However, Bisbee also fails to teach the missing portions of the claimed candidate identifier lifecycle. The passages cited in the Office Action that supposedly read on “receiving... the candidate identifier” (limitation (c)) and “distributing... in response to

receiving the candidate identifier” (limitation (d)), instead discuss only the act of digitally signing electronic documents, and fail to mention either candidates or identifiers. Indeed, and in addition, since limitation (c) requires that the outside user has “received the candidate identifier directly or indirectly from the candidate” and since none of the offered references can get the identifier to the candidate in first place, it cannot possibly be the case in limitation (c) that the outside user has “received the candidate identifier directly or indirectly from the candidate”. These passages therefore fail to disclose or suggest these claim limitations, which the Examiner has already admitted are not found in the other cited art. See Office Action, p. 4.

Indeed, it is not immediately clear from the Office Action what disclosure in Bisbee is meant to play the role of the candidate identifier, despite the Office’s blanket assertion that such an identifier is present. Nevertheless, the undersigned attorney has carefully read Bisbee in an attempt to locate the candidate identifier to which the Office is alluding. The words “candidate” and “identifier” are nowhere to be found in this reference. The closest disclosure that was located occurs in the paragraph beginning in col. 4, line 61, which discusses “personal identification information such as the recipient’s biometric information... or a PIN.” But this information is not the claimed candidate identifier. As before, this information is not communicated to a candidate. Also, it is not received from an outside user wanting verification of the candidate’s personal background data, the outside user having received the candidate identifier directly or indirectly from the candidate. Further, biometric information pertains to the individual’s physical characteristics, not her background, and thus cannot be the claimed “background information.”

The Office has therefore failed to establish a *prima facie* case of obviousness, because it has failed to account for all of the claim limitations, and in particular has failed to account for at least three limitations. The cited art fails to disclose or suggest, alone or in combination, a candidate identifier that is first established, then communicated to the candidate, received by the outside user directly or indirectly from the candidate, and finally received from the outside user, as claimed. The cited prior art also fails to disclose or suggest receiving a candidate identifier from an outside user wanting verification of the candidate’s personal background data, the outside user having received the candidate identifier directly or indirectly from the candidate, as claimed. Finally, the cited prior art fails to disclose or suggest distributing an electronic

document to the outside user in response to receiving the candidate identifier. For at least these reasons, the applicants respectfully request that the rejections be withdrawn.

3. The combination of Walker with the other cited art would make Walker unsuitable for its intended purpose

Even if the cited art taught all of the limitations of the claims (which it does not), the combination of references would still not be obvious to a person having ordinary skill in the art, because it would render Walker unsuitable for its intended purpose of providing electronic-based communications between parties without revealing the identity of either party. In making a rejection under 35 U.S.C. § 103(a), obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. However, as a matter of law, there is no suggestion or motivation to make a proposed modification if it would render the prior art invention being modified unsatisfactory for its intended purpose. MPEP 2143.01(V); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).¹ This is precisely the kind of modification that the Office has made here: the combination of Walker with Ballantyne (and Bisbee) undermines Walker's expressly stated purpose. Thus, the rejections based on the combination of these three references also should be withdrawn for this reason.

Walker is directed to a method and system for facilitating anonymous communications. Walker, title and abstract. Walker's intended purpose is to provide a system that allows for electronic-based communications between parties without revealing the identity of either party. This purpose is elaborated in many different, expressly stated goals. Walker, col. 4 lines 17-53. Anonymity is the paramount concern, and the concept permeates every paragraph of the patent, from its title to its claims. Walker's disclosure is diametrically opposed to, and incompatible with, systems in which the two parties know each other's identities before communication. As the *Gordon* court stated: in effect, the primary reference itself teaches away from the proposed modification.

To be specific, the claims of the present application break the anonymity between the candidate and the outside user. Claim 1 expressly states that the candidate identifier "identifies the candidate." The outside user has "received the candidate identifier directly or indirectly from

the candidate.” Walker’s goal of preserving the candidate’s anonymity, and his carefully constructed system for doing just that, are both fundamentally inconsistent with these claim limitations—it is impossible for Walker’s invention to maintain the anonymity of any candidate who, directly or indirectly, communicates information identifying himself to an outside party. By combining Walker with limitation (b) of claim 1 (the purpose for which Ballantyne is cited, regardless of Ballantyne’s actual disclosure), the Office destroys the function of Walker’s invention, rendering it unsuitable for its expressly stated purpose. The same result obtains by combining Walker with limitation (c) of claim 1 (the purpose for which Bisbee was cited). Thus, as a matter of law, there is no motivation for combining Walker with Ballantyne and Bisbee in this way.

The motivation provided in the Office action for combining Walker with Ballantyne does not address the unsuitability issue. The motivation given by the Office is “to make sure personal background data can be distinctively identified in a secure manner.” Office action, p. 4. Yet Walker already provides this functionality in the form of transaction IDs. See Walker, col. 17, lines 4-45. There is no motivation to combine Walker with another reference to obtain this functionality—it’s already present in Walker. Further, from Walker’s perspective, providing a candidate identifier to an outside party is insecure, as doing so directly contradicts Walker’s primary goal of preserving anonymity.

A person having ordinary skill in the art would therefore have no motivation to combine Walker with Ballantyne and Bisbee (or with any reference that undermines Walker’s carefully constructed anonymity) to reach the limitations of the claims. Indeed, a skilled person would have a strong disincentive against making such a combination, as doing so would render Walker’s system ineffective. Thus, the Office has failed to establish a *prima facie* case of obviousness in the combination of Walker, Ballantyne, and Bisbee. For at these reasons, the applicants respectfully request that the § 103(a) rejections be withdrawn.

Conclusion

The prior art of record does not teach all of the claim limitations, and it would not have been obvious to combine the cited references as suggested. Thus, the applicants respectfully

¹ <http://ftp.resource.org/courts.gov/c/F2/733/733.F2d.900.83-1281.124312.html>

submit that the claims are allowable over the cited references. As the pending claims are believed to be allowable, the applicants respectfully request allowance of the application. The applicants further request that the Examiner contact the undersigned, David E. Blau, if doing so will assist further examination of this application.

The applicants do not believe any extension of time is required for timely consideration of this response. In the event that an extension has been overlooked, this conditional petition of extension is hereby submitted. Please charge deposit account number 19-4972 for any fees that may be required for the timely consideration of this paper.

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Respectfully submitted,

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